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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,179	07/18/2003	Christopher Lee Berg	M81.12-0060	2674

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EXAMINER

RAMANA, ANURADHA

ART UNIT PAPER NUMBER

3733

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/623,179	BERG ET AL.	
	Examiner	Art Unit	
	Anu Ramana	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-19 is/are rejected.
- 7) ☒ Claim(s) 20-22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/23/05</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference element mentioned in the description: "73." Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the Examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 22 is objected to because of the following informalities. The following changes are required to avoid confusion. In line 2, "in" should be replaced with - - at - - and in the same line, "providing the force as applied" should be replaced with - - applying a force - -. Suitable correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Whitt (4,373,709).

Whitt discloses a surgical limb holder 10 that can be used to hold a limb in any position, the holder mounted to a surgical table having a support 11, arms 29 and a flexible strap 42 that can be used to restrain a lower portion of a leg or "lower leg" (Figs. 1 and 3, col. 1, lines 19-21 and col. 2, lines 18-39).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler, Jr. (US 6,190,312) in view of Fowler (US 5,964,698) and Greishaber (US 4,813,401).

Fowler, Jr. discloses a conventional or variable geometry retractor frame with arms 12a and 12b and a retractor stay apparatus attached to an elastic member wherein the elastic member is received in a notch of a member attached to the frame (Fig. 1, cols. 4 and 5 and col. 8, lines 11-28).

Fowler, Jr. discloses all elements of the claimed invention except for the frame being attached to the rail of a surgical table and a retractor stay apparatus such as a blade.

Retractor stay members such as paddles or "blades" and hooks attached to elastic members are well known as illustrated by Fowler (Fig. 6 and col. 1, lines 44-52).

Greishaber teaches supporting a retractor frame by mounting it to a rail 8 of a surgical table (Fig. 1, cols. 5 and 6).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided stay members such as blades in the Fowler, Jr. apparatus since such stay members are well known in the art for retracting tissue. Further, it would have been obvious to one of ordinary skill in the art at the time

the invention was made to have mounted the retractor apparatus of the combination of Fowler and Fowler, Jr. to an operating table, as taught by Greishaber as it is common knowledge in the retracting art to support a conventional retractor frame by mounting it to a surgical table.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitt (US 4,373,709).

Whitt discloses that limb holder 10 can be utilized in any position that will enhance and facilitate surgery (col. 1, lines 6-22). See previous discussion for claim 19.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the limb holder 10 to restrain the lower leg or "tibia" to provide support without discomfort.

The method steps of claims 17 and 18 are rendered obvious by the above discussion.

### ***Response to Arguments***

Applicant's arguments submitted under "REMARKS" in the response filed on September 23, 2005 have been fully considered by the Examiner.

Although Applicant states that a Replacement Sheet with Figure 2 has been submitted with the office action, no such sheet was found. Accordingly, the Examiner is maintaining the objection to the Drawings.

The amendments to claims 13, 14 and 19 have overcome the rejections under 35 USC 101 made in the previous office action.

Applicants' arguments with respect to the rejection of claim 19 under 35 USC 102(b) as being anticipated by Whitt are not persuasive for the following reasons. Although Applicant states that Exhibits A, B and C are attached to the response, no such Exhibits were found by the Examiner. Regardless, Whitt clearly discloses that limb holder 10 can be readily adjustable to a great variety of positions, sizes and attitudes so that a limb can be held in any position that will enhance and facilitate surgery (col. 1,

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lines 19-22). Regarding the limitations, "for use in securing ...elevated position," and "for engaging the lower leg.....in position," it is noted that "while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Applicant's arguments with respect to the rejections of claims 17 and 18 under 35 USC 103(a) as being unpatentable over Whitt are not persuasive because Whitt clearly discloses that limb holder 10 can be used to hold a limb in a position desired by the surgeon during surgical procedures performed on the limb (col. 1, lines 16-18). It is the Examiner's position that knee surgery is an exemplary surgical procedure during which a surgeon can hold the lower leg using the Whitt apparatus, if so desired.

### ***Allowable Subject Matter***

Claims 1-8 are allowed.

Claims 20, 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR

*Anuradha Ramana*  
February 25, 2006

  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER